



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SLC

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/960,431 10/29/97 SUGIYAMA

M 30598.0004

┌

QM12/1220

└

EXAMINER

NGUYEN, G

TROY M SCHMELZER  
SNELL & WILMER  
ONE ARIZONA CENTER  
PHOENIX AZ 85004-0001

ART UNIT

PAPER NUMBER

3723

9

DATE MAILED:

12/20/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/960,431

Applicant(s)

Sugayama et al.

Examiner

Nguyen

Group Art Unit

3723

☒ Responsive to communication(s) filed on Oct 10, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-21 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-21 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3723

### DETAILED ACTION

Receipt is acknowledged of Applicant's amendment filed on October 10, 2000.

Claims 1-21 are presented for examination.

#### *Reissue Applications*

Claims 1-21 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.* 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) related subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The limitations omitted in the reissue are “~~an annular shape with~~”, “radial direction of”, and “and perpendicular to the radial direction”. These provides broadening aspect to the reissue claims that was clearly argued in the original application amendment filed on May 17, 1996 to overcome the rejection based on *Bombardier et al.* '021 in view of JP'870, *Beasley* '963, *Ruark et*

Art Unit: 3723

al.'681, and Holzhauer filed on February 26, 1996. Thus, the omitted limitation relates to subject matter previously surrendered, in the original application.

### ***Response to Arguments***

1. Applicant's arguments filed October 10, 2000 have been fully considered but they are not persuasive. Applicants' arguments to the limitations sought to be deleted in the reissue claims are immaterial because the failure to appreciate the more narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C Section 251 and that the broader scope surrendered in the application for patent cannot be recaptured in the present reissue application.

### ***Conclusion***

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3723

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Nguyen whose telephone number is (703) 308-0163. The examiner can normally be reached on Monday-Friday from 7:00 AM-3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Hail, can be reached at (703) 308-2687. The fax number for this Group is (703) 305-3579.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 308-1148.

**George Nguyen**  
**Patent Examiner**

George Nguyen

12/16/2000



**Joseph J. Hail, III**  
**Supervisory Patent Examiner**  
**Technology Center 3700**